

Applicant : Beth Marcus, et al
Serial No. : 10/699,555
Filed : October 31, 2003
Page : 2 of 4

Attorney's Docket No.: 19146-002001

RECEIVED
CENTRAL FAX CENTER

JUL 14 2006

REMARKS

The Office Action identified the following allegedly patentably distinct species: Figs. 3a-3d directed to species 1; Figs. 4a-4b directed to species 2; Figs. 5a-5b directed to species 3; Figs. 6a-6b directed to species 4, and Figs. 7a-7b directed to species 5. See Office Action at page 2 ¶ 1. Claims 1, 3-6, 9-21, 23-55 fall within Group 1 drawn to species 1. Claim 8 falls within Group 2 drawn to species 4. Claim 7 falls within Group 3 drawn to species 5. No claims fall within species 2 or species 3. Claims 2 and 22 were cancelled in the previous preliminary amendment. Claims 1, 12, 17, 24, 28, 29, and 43 are generic to all species. Applicants elect Group 1 drawn to the species 1 of Figs. 3a-3d with traverse. See Office Action at page 2 ¶ 1.

Traversing Restriction/Election Under 37 C.F.R. § 1.143

Applicants request reconsideration of the restriction requirement pursuant to 37 C.F.R. § 1.143 and respectfully request that the requirement be withdrawn since the Office Action fails to clearly outline the reasons for holding that the alleged distinct species are present.

The Office Action alleges that Figures 3a-3b, 4a-4b, 5a-5b, 6a-6b, 7a-7b comprise 5 patentably distinct species. The Examiner has the burden to concisely state, "[t]he particular reasons relied on ... for holding that the inventions as claimed are independent or distinct." See M.P.E.P. § 808.01. However, the Office Action fails to state any such reasons, apparently basing the restriction solely on the cited Figures. See Office Action at page 2 ¶ 1. As such, Applicants respectfully request that Examiner concisely state the particular reasons for holding the inventions independent and distinct.

Each of the figures cited in the Office Action depicts a hand-held electronic device wherein a second input assembly of the device includes different types of input elements: Figures 3a-3b depict a "pressure sensitive pad," Figures 4a-4b depict a "touch pad," Figures 5a-5b depict "two dimensional rockers," Figures 6a-6b depict a "D-pad and two contact sensors," Figures 7a-7b depict "rotary dials." See Specification at page 8 lines 13-22. The specification discloses, "a flexible and efficient human interface and input system ... that utilize[s] the opposed thumb and finger ergonomics inherent in the hand..." See Specification at page 5 lines 20-23. The human interface implemented as a device having two input assemblies: "...the first input assembly 340 on the front-side surface 312 and the second input assembly 350 on the back-

Applicant : Beth Marcus, et al
Serial No. : 10/699,555
Filed : October 31, 2003
Page : 3 of 4

Attorney's Docket No.: 19146-002001

side surface 314, left-side surface 316 and right-side surface 318, is configured to take advantage of the biomechanics of the hand..." See Specification at page 13 lines 19-23; emphasis added.

The first and second assemblies can include a number of various input elements. For example in Figures 3a-b, the specification describes implementing the second input assembly 350 to include a pressure sensor pad 354. See *id.* at page 11, lines 2-28. However, the input elements 352 and 354 disposed on the first and second assemblies of Figure 3a-b can include a other suitable input elements including, for example, a pressure sensitive pad, a touch pad, rockers, a D-pad, and/or rotary dials. See *id.* at page 12 lines 3-8. Any of the disclosed input elements may be used on the second surface: "[i]t is to be understood that the input elements [on the second surface] ... could be analog and/or digital buttons, keys, rockers (which may be a one or more position buttons or an analog joystick-type button), sliders, dials or touch pads ... positional sensors (such as rotary encodes, linear potentiometers and the like) or other sensors or combinations of them." See *id.*; emphasis added. Thus, the Figures 4a-4b, 5a-5b, 6a-6b, and 7a-7b, are only illustrative of the above mentioned variations in the input elements disposed on the first and second assembly of the human interface device.

For at least these reasons, the election/restriction of species requirement is improper and should be withdrawn.

Upon the allowance of generic claims 1, 12, 17, 24, 28, 29, and 43, Applicants reserve the right to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Applicant : Beth Marcus, et al
Serial No. : 10/699,555
Filed : October 31, 2003
Page : 4 of 4


Attorney's Docket No.: 19146-002001

CONCLUSION

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: July 14, 2006


John P. Schnurer
Reg. No. 52,196

Fish & Richardson P.C.
PTO Customer No. 20985
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

10647716.doc